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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/759,706	01/16/2004	Huei-Hsin Sun	NS132-62 (15737/273)	8444

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EXAMINER	
BUI, HUNG S	

ART UNIT	PAPER NUMBER
2841	

DATE MAILED: 01/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/759,706	SUN ET AL.	
	Examiner	Art Unit	
	Hung S. Bui	2841	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *03 November 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1 and 3-7* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1 and 3-7* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 1, 3-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dubhashi [US 2003/0080413] in view of Takagi [US 6,396,854] and Ogura et al. [US 4,694,440].

Regarding claims 1 and 3-4, Dubhashi discloses an assembly (figures 1-2) for enclosing an electronic element (21) of electronic device (figure 1) comprising:

- a housing (30, 50) for enclosing the electronic element;

- a seal filling tube (60, figure 2) for a fluid (figure 1) of non conductive high heat capability injected into the filling tube surrounding the electronic element (paragraph 19).

Dubhashi discloses everything claimed except the filling hole being first and second holes with stop members capable of evacuating air from the housing during the fluid injection process and the housing being formed of a rubber material.

Takagi discloses a housing (31, figure 2) for an electronic element (30) having a pair of injection holes (32, 33) with stopper member (36) capable of evacuating air from the housing during a fluid injection process.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use a pair of injection holes with the housing of Dubhashi, as suggested by Takagi, for the purpose of completely evacuating the chamber during the fluid injection process.

Ogura et al. disclose a rubber housing (3, 32) for an electronic element (1) formed of a rubber material (column 2, lines 9-24).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the rubber casing design of Ogura et al. for the housing of Dubhashi, as modified, for the purpose of protecting electronic device.

Regarding claim 5, Takagi further teaches the use of silicon oil for the fluid.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use silicon oil for the fluid of Dubhashi, as modified, for the purpose of improving heat dissipation.

Regarding claim 6, Dubhashi, as modified, disclose the claimed invention except for the use of hydro oil for the fluid. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use Hydro oil for the fluid of Dubhashi, as modified, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

3. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dubhashi, as modified, as applied to claim 1 above, and further in view of Matayabas, Jr. et al. [US 6,597,575].

Dubhashi, as modified, disclose everything claimed except the fluid being semisolid.

Matayabas, Jr. et al. disclose the use of a gel as a heat transfer medium (column 2, lines 23-41).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use a semisolid/gel for the substance of Takagi, as suggested by Matayabas, Jr. et al., in order to improve heat dissipation characteristics and reduce stress.

Response to Arguments

4. Applicant's arguments filed 11/03/2004 have been fully considered but they are not persuasive.

Applicant argues:

[1]: Takagi is non-analogous art.

[2]: Examiner uses hindsight to form the combination.

[3]: There is no motivation to combine Takagi with Ogura et al.

[4]: Takagi is for a different purpose and does not face or solve the problems faced and solved by the present invention.

[5]: Takagi does not disclose that it is deficient or suggest the possibility of further improvement.

Examiner disagrees:

Regarding [1], In response to applicant's argument that Takagi is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, both Takagi and applicant desire to surround a component with fluid. A skilled artisan would seek alternative fluid management designs to evacuate air from the housing during injection.

Regarding [2], In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Regarding [3], The rubber casing of Ogura et al. would provide protection from vibration for the component. A skilled artisan would have been motivated to use the rubber in order to protect the component from damage due to vibration.

Regarding [4], The reason or motivation to modify the reference may often suggest what the inventor has done, but for a different purpose or to solve a different

problem. It is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by applicant. See MPEP 2144.

Regarding [5], In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller,* 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). The rationale to modify or combine the prior art does not have to be expressly stated in the prior art; the rationale may be expressly or impliedly contained in the prior art or it may be reasoned from knowledge generally available to one of ordinary skill in the art, established scientific principles, or legal precedent established by prior case law. See MPEP 2144.

Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hung S. Bui whose telephone number is (571) 272-2102. The examiner can normally be reached on Monday-Friday 8:30AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kamand Cuneo can be reached on (571) 272-1957. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

12/28/04
HB

RANDY W. GIBSON
PRIMARY EXAMINER